



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,188	07/24/2001	Wynn Bailey	310048-628199	5730

24201 7590 01/04/2005

FULWIDER PATTON LEE & UTECHT, LLP
HOWARD HUGHES CENTER
6060 CENTER DRIVE
TENTH FLOOR
LOS ANGELES, CA 90045

EXAMINER

TRAN, QUOC A

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/912,188	BAILEY ET AL.	
	Examiner	Art Unit	
	Quoc A. Tran	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/684055 & 60/201234.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/25/02; 9/7/01</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to Amendment A, filed 09/27/2004.
2. Claims 1-48 are currently pending in this application. Applicant elects to prosecute Group II, claims 27-36, without traverse. Claim 27 is independent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jetcha et al. US006631375B2 - filed 12/02/1998 (hereinafter '375), in view of Gever et al. US006313835B1 - filed 04/09/1999 (hereinafter '835).**

In regard to independent claim 1, "*retrieving product data from at least one non-executable data file according to the user's product selection*", as taught by '375 at col. 4, line 65 through col. 5, line 20 (i.e.... The document template 214 may have fixed information, such as logos, images, fonts, and positions of text information, and the logos and images... the user of the second client computer 201 may be queried to submit information for a form having tags corresponding to criteria of the document template 214. For example, the criteria may include the user's first name, last name,

phone number, etc. The user types in his or her information corresponding to these criteria. ... which can be modified via a web browsing program as known in the art... The invention is also not limited to any particular document 214... document 214 is a business card; however, other documents amenable to the invention include self-adhesive notes (such as those available from 3M, Inc., as Post-It notes), letterheads, pamphlets, brochures, envelopes, etc...). Examiner reads, document template 214 may have fixed information, such as logos, images, fonts, and positions of text information, and the logos and images, which could interpreted as claimed "*non-executable data file*".

"presenting on the computer screen a plurality of fields for the user to input product tailoring information, said fields being determined by said product data within said non- executable data file", as taught by '375 at col. 9, lines 15-35 (i.e... screen displayed on a display device of a computer in conjunction with one embodiment of the invention are shown. More particularly, the diagrams are screens regarding the filling in of forms to create a document from a document template.... the user is able to enter various phone numbers in fields...),

"presenting on the computer screen a preview of the user's selected product, said preview being reflective of said product data retrieved from the non-executable data file and said product tailoring information input by the user", as taught by '375 at col. 9, lines 40-50 (i.e... Once the user has entered in this information, button 528 is clicked. This causes display of the screen shown in FIG. 5c, where the document

template has been changed to a document 530 indicative of the information entered in by the user...).

'375 does not teach, *"presenting on a computer screen a list of available products and receiving from a user in response thereto a product selection defining a user's selected product"*, however as taught by '835 at col. 8, lines 5-15 (i.e... The Web site of server 26 displays a list of categories from which the user may select for inclusion in the Web page. The categories may include, for example, photo albums, advertisements, greeting cards, and resumes....).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified '835 into '375 to provide a way, wherein presenting on a computer screen a list of available products and receiving from a user in response thereto a product selection defining a user's selected product. One of the ordinary skills in the art would have been motivated to perform such a modification to provide users the selected tools for and/or change text inscriptions associated with the greeting cards and preparing Web pages, such as Dreamweaver, produced by Macromedia, are relatively complex, as taught by '835 col. 1, lines 30-45 (i.e... prepare Web pages, such as Dreamweaver, produced by Macromedia, are relatively complex...).

In regard to dependent claim 28, *"data file further includes default product tailoring information"*, as taught by '375 at col. 6, lines 1-15 (i.e... includes associating the user with a particular directory on the server computer (e.g.... a set of defaults

regarding options available to the user within the authoring program (e.g., images and commands...).

In regard to dependent claim 29, *"default tailoring information contains default graphics"*, as taught by '375 at col. 6, lines 1-15 (i.e... includes associating the user with a particular directory on the server computer (e.g.... a set of defaults regarding options available to the user within the authoring program (e.g., images and commands...)).

In regard to dependent claim 30, *"default tailoring information contains default text"*, as taught by '375 at col. 6, lines 1-30 (i.e... includes associating the user with a particular directory on the server computer (e.g.... a set of defaults regarding options available to the user within the authoring program (e.g., fonts, colors, images and commands), and an authorization level... determining which logos and images are to be fixed in any document created therefrom, as well as the font type and sizes, as well as position of allowable text entry...).

In regard to dependent claim 31, *"a first group of products, said first group of products all having a common SKU number but different default tailoring information, and a second group of products which may include a member of said first group of products, said second group of products having different SKU numbers"*, as taught by '375 at col. 6, line 15 through col. 7, line 10 (i.e...the first client then uses the authoring program to create a document template, such as a business card, a letterhead, etc...Once the document template has been created, the first client selects a save command, which uploads the document template to the server, where it is saved, in

step 306.... the user of the second client is only able to enter in and change information present as prescribed by the document template...), also as taught by '375 at col. 5, lines 1-15 (i.e... The document template 214 may have fixed information, such as logos, images, fonts, and positions of text information, and the logos and images....the user of the second client computer 201 may be queried to submit information for a form having tags corresponding to criteria of the document template 214....The user types in his or her information corresponding to these criteria. A search and replace is then performed, replacing the criteria with the information entered by the user. The tags of the form indicate which information is to replace which criteria.... The invention is also not limited to any particular document 214. In one embodiment of the invention, document 214 is a business card; however, other documents amenable to the invention include self-adhesive notes (such as those available from 3M, Inc., as Post-It notes), letterheads, pamphlets, brochures, envelopes, etc...). Examiner reads, the first client then uses the authoring program to create a document template such as a business card, a letterhead, etc..., which could interpreted as claimed, *"first group of products all having a common SKU number but different default tailoring information"*, *SKU is define as*, files to represent products within a product line. Such files may be called "project objects," "product object files" or "SKU object files" and contain descriptive product data therein see specification page 6, paragraph [0014].

In regard to dependent claim 32, *"non-executable data files are selected from the group consisting of ... XML files."*, as taught by '375 at col. 5, lines 10-35 (i.e...

document 214 is a business card...invention include self-adhesive notes (such as those available from 3M, Inc., as Post-It notes), letterheads, pamphlets, brochures, envelopes, etc... Other file formats suitable for prepress include XML...). Examiner reads document 214 is a business card, which could interpreted as claimed "*non-executable data files*".

In regard to dependent claim 33, "*computer screen displays a world wide web page*", as taught by '375 at col. 3, lines 25-30 (i.e.... Computer 110 also desirably has at least one web browser application program running with at least one operating environment, to permit users of computer 110 to access intranet or Internet world-wide-web pages...)

In regard to dependent claims 34-35, incorporate substantially similar subject matter as cited in claim 27 above, and is similarly rejected along the same rationale.

In regard to independent claim 36, is directed to a computer readable media for performing the method of claim 27 and is similarly rejected along the same rationale.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cohen US006263352B1

filed 11/14/1997

Pulliam et al US006609108B1

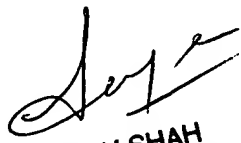
filed 04/04/2000

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (571) 272-4103. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for Published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SANJIV SHAH
PRIMARY EXAMINER

Quoc A. Tran
Patent Examiner
Technology Center 2176
December 23, 2004